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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/517,019 | 06/13/2005 | Klaus Kespohl | 915-006.069 | 8678 |
| 4955 7590 01/17/2008 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468 | | | EXAMINER AFSHAR, KAMRAN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,019

Applicant(s)

KESPOHL ET AL.

Examiner

Kamran Afshar 571-272-7796

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>03/04/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to Preliminary Amendment filed on 12/02/2004.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SIEMENS (XP-002232615, Publication Date of 12/13/2000) in view of Nagase (U.S. Pub. No.: 2002/0037751 A1).

With respect to claims 1, 15, SIEMENS discloses a method for controlling functions of a digital music player implemented in a mobile communication device or a mobile communication device (See SIEMENS e.g. Page 5, column 1, "phone"), comprising a plurality of device applications (See SIEMENS e.g. Page 12, "phone call"; Page 18, "Addressbook") including a digital music player (See SIEMENS e.g. Page 25, "MP3 Player"), a mode selector (See SIEMENS e.g. Page 26, "Options"-"Create playlist" and "Return-to the MP3 player list") for switching an input mode into a first mode (See SIEMENS e.g. Page 26, "Create playlists") and into a second mode (See SIEMENS e.g. Page 25, "Play"), the mode selector being operable to change, modes in at least one application (See SIEMENS e.g. Page 25, "MP3 Player"), a multiple input switch (See SIEMENS e.g. Page 4, "Control key") the switch being operable to receive a user input and to generate and transmit commands to a plurality of device applications (See SIEMENS e.g. Page 25, "MP3 Player" and Page 31, "Calendar") wherein the commands include a first set of commands (See SIEMENS e.g. e.g. Page 26, "select. melody in the MP3 player list") operable with the input mode being the first mode and a second set of commands (See SIEMENS e.g. Page 25, section "Control", "Jump forward or back one track", Play/pause") with the input mode being in the second

mode (See SIEMENS e.g. Page 25, "Play") wherein the first set of commands corresponding to the first mode are adapted to control device applications (See SIEMENS e.g. Page 26, "MP3 Player") and the second set of commands corresponding to the second mode are adapted to control a set Of music player functions (See SIEMENS e.g. Page 25, "MP3 Player") wherein said second mode is exclusively dedicated to the controlling of said music player functions (See SIEMENS e.g. SIEMENS, Page 26) independent from the current operation mode of the mobile communication device (See SIEMENS e.g. Page 26, menu → Surf/Fun → MP3 Player, option, create list, OK, add, add song, select, etc. Page 26, Also See MP3 Player Menu option, Page 27). However Siemens is silent that a controller connected to the multiple input switch and to the mode selector. In an analogous field of endeavor, Nagase teaches a similar portable terminal (or a mobile communication device) and controlling method thereof (See Nagase e.g. Title, Page 1, ¶ [0003]). Further, Nagase teaches the concept of a controller connected to the multiple input switch and to the mode selector (See Nagase e.g. CPU 15 and key 19 connected via i/o 14 of Fig. 1, 9a-9f keys of Fig. 2). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Nagase to SIEMENS to provide a keypad key unit 9 (or keypad) includes number of key switches which functions as dial key, volume control key, a mode selection key and the like being connected to a CPU 15 (or processor or controller or microcomputer) of Fig. 1 enabling a user of the mobile communication device to perceive an input operation quickly and accurately as suggested (See Nagase e.g., Page 2, ¶ [0031], Page 1, ¶ [0010]).

Regarding claim 8, it is obvious that a third set of commands (See SIEMENS e.g. choose a melody via control key and or with the side keys, "press" or press briefly on the right, Page 25) is provided operable with the input mode being in the first (See SIEMENS e.g. Page 26, "Create playlists") or the second mode (See SIEMENS e.g. Page 25, "Play"), the third set of commands being adapted to control a subset (See SIEMENS e.g. choose a melody via control key and or with the side keys, "press" or press briefly on the right, Page 25) of music player functions (See SIEMENS e.g. Menu → Surf/Fun → MP3 Player, Page 25).

Regarding claim 10, it is obvious that the second mode is active during depressing and holding the mode selector (See SIEMENS e.g. "control key" , "hold down", Page 25).

3. Claims 2-5, 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over SIEMENS, Nagase and further in view of Dutta (U.S. Pub. No.: 2002/0161780 A1).

Regarding claim 2, SIEMENS and Nagase teach everything as discussed above in the rejected claims 1, and 15. SIEMENS further teaches a plurality of pieces of music are arranged in a predetermined sequence (See SIEMENS e.g. MPE Play, "Reggae" , "Kleine Nachtmusi" , "Opus No.3", Page 25), characterized in that the second set of commands comprises commands out of a group comprising: a starting function of the music reproduction; a stopping function of the music reproduction; a fast forward winding function of the reproduced piece of music; a fast backward winding function of the reproduced piece of music(See SIEMENS e.g. control key: press play (or start), stop, fast forward, fast reverse Page 25). However, SIEMENS and Nagase do not teach a skipping forward function to a subsequent piece of music; and a skipping backward function to a preceding piece of music. In an analogous field of endeavor, Dutta teaches a vigorously well know concept of a skipping forward function to a subsequent piece of music; and a skipping backward function to a preceding piece of music (See Dutta e.g. Page 4, Lines 7-11 of ¶ [0038], 351, 361-366 of Fig. 3). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Dutta to Nagase and SIEMENS to provide a user interface controls such as a forward button, backward button, fast forward button, fast reverse button, stop, and play, etc. For a given type of multimedia object, operations on the object such as play, rewind, etc. in order to retrieve a previous or next multimedia object (or song or melody or music, etc.) as suggested by (See Dutta e.g. Page 4, Lines 7-11 of ¶ [0038], Page 5, Line 11 of ¶ [0047]).

Regarding claim 3, it is obvious that the fast forward winding function of the reproduced piece of music and the fast backward winding function of the reproduced piece of music (See SIEMENS e.g. MPE Play, "Reggae" , "Kleine Nachtmusi" , "Opus No.3", Page 25) are activated by pressing and holding the multiple input switch (See SIEMENS e.g. control key, Page 25) in the input mode being in the second mode for a certain period of time (See SIEMENS e.g. press briefly, hold down, Page 25).

Regarding claim 4, it is obvious that the skipping forward function to a subsequent piece of music in order to retrieve a previous or next multimedia object (or song or melody or music, etc.), Page 5, Line 11 of ¶ [0047]) and the skipping backward function (See Dutta e.g. Page 4, Lines 7-11 of ¶ [0038], 351, 361-366 of Fig. 3) to a preceding of music are activated by pressing and releasing the multiple input switch (See SIEMENS e.g. control key, Page 25) in the input mode being in the second mode for a certain period of time (See SIEMENS e.g. press briefly, hold down, Page 25).

Regarding claim 5, it is obvious that mode selector (See SIEMENS e.g. Page 26, "Options"- "Create playlist" and "Return-to the MP3 player list") is reserved for switching exclusively the input mode into the first mode (See SIEMENS e.g. Page 26, "Create playlists") and the second mode (See SIEMENS e.g. Page 25, "Play").

Regarding claim 11, it is obvious that a user interface being adapted to control the device applications, characterized in that the first set of commands is adapted to provide a browsing function through the user interface (See Dutta e.g. user can input commands to control the browser program 6 through the graphical user interface (GUI) generated by the browser 6 or input device controls, such as keyboard keys, etc. that are programmed to cause the browser to perform specific operations, Page 3, Lines 9-14 of ¶ [0034]).

4. Claim 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over SIEMENS, Nagase and further in view of Cistulli (U.S. Patent 5,946,376 A).

Regarding claim 12, SIEMENS and Nagase teach everything as discussed above in the rejected claims 1, and 15. SIEMENS further teaches comprising: a display (240) for displaying the user interface to a user (See SIEMENS e.g. mobile communication Display, Page 4). However, SIEMENS and Nagase do not teach the display being coupled to the controller via a display driver. In an analogous field of endeavor, Cistulli teaches display being coupled to the controller via a display driver (See Cistulli e.g. keypad 15 (or user interface), microprocessor 20 (or controller), LCD Driver 40, Display 30 of Fig. 1). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Cistulli to Nagase and SIEMENS to provide display driver for driving the display in a mobile communication device as suggested (See Cistulli e.g. Co. 2, Lines 28-33).

Regarding claim 13, it is obvious that that a music player control user interface (SIEMENS e.g. "the MP3 player list is displayed", Page 26) is displayed to the user in the second mode (See SIEMENS e.g. Page 25, "Play").

Regarding claim 14, it is obvious that the input mode (See SIEMENS e.g. "control key", "open Menu", Page 4) is automatically switched into the second mode (See SIEMENS e.g. Menu → Audio, Page 5) in case a music player control user interface is displayed (See SIEMENS e.g. Menu → Surf/Fun → MP3 Player, Page 25).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,133,706 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both basically claim the same subject matter except the instant claims are to a "A mobile communication device, comprising: a plurality of device applications including a digital music player; a mode selector for switching an input mode into a first mode and into a second mode," whereas the patented claims are to a more generic "A mobile communication device, comprising: a set of keys organized as a keyboard, wherein each key of said set of keys has a first assigned function for entering alphanumeric text". Therefore, it would have been

obvious to one ordinary skill in the art at the time of the invention to implement the patented "A mobile communication device, comprising: a set of keys organized as a keyboard, wherein each key of the set of keys has a first assigned function for entering alphanumeric text" as a 'A mobile communication device, comprising: a plurality of device applications including a digital music player; a mode selector for switching an input mode into a first mode and into a second mode" because it was notoriously well known to utilize a multifunctional input (or a control key) in a mobile communication device to switch between a call number (or dialing mode / function / state) or character inputting state and or selecting an MP3 Player.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Allowable Subject Matter

6. Claims 6-7, 9, 16 are objected to as being dependent upon a rejected base claim, but would be allowable Upon filing a suitable Terminal Disclaimer and proper overcome of the ***Double Patenting rejection*** as discussed above in items 5, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 6, the prior art of record fails to disclose singly or in combination or render obvious that characterized in that the multiple input switch has at least four switching positions, wherein the at least four switching positions comprises a first set of switching positions and a second set of switching positions, the switching positions of the first set and the second set being arranged

opposite to each other; wherein the multiple input switch operated in one position of the first and/or second set of switching positions causes a commands out of the second set of commands corresponding to the input mode being in second mode; wherein the multiple input switch operated in one position of the first set of switching positions causes a command out of the second set of commands comprising at least browsing functions to control a user interface and corresponding to the input mode being in the first mode.

Regarding claim 9, the prior art of record fails to disclose singly or in combination or render obvious that characterized in that at least a set of symbols printed on the multiple input switch indicates the music player functions to be controlled and wherein the set of symbols and the mode selector have substantially a common color.

Regarding claim 16, the prior art of record fails to disclose singly or in combination or render obvious that characterized in that generating a command from the received input signal in combination with the input mode, the command being one of a plurality of commands including a first set of commands generated in the first mode, a second set of commands generated in the second mode and a third set of commands generated in the first mode and the second mode; and in case the generated command is one of the third set of commands, transmitting the generated command to the digital music player to control another set of music player functions.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a) Ito (U.S. Pub. No.: 2001/0053692 A1).
 - b) Kivela (U.S. 6,052,070 A).
 - c) Muurinen (U.S. 5,408,060 A).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Eng, George** can be reached @ (571) 272-3984. The fax number for the organization where this application or proceeding is assigned is **571-273-8300** for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamran Afshar